

REMARKS

Claims 1-3, 5-9, 11, 12, and 14 have been amended. Claims 4, 10, and 13 have been cancelled. Claims 15-20 have been added. No new matter has been added. Claims 1-3, 5-9, 11, 12, and 14-20 are pending.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

Claims have been amended, and claims have been canceled, notwithstanding the belief that these claims were allowable. Except as specifically admitted below, no claim elements have been narrowed. Rather, cosmetic amendments have been made to the claims and to broaden them in view of the cited art. Claims 1-3, 5-9, 11, 12, and 14 have been amended solely for the purpose of expediting the patent application process, and the amendments were not necessary for patentability.

Any reference herein to "the invention" is intended to refer to the specific claim or claims being addressed herein. The claims of this application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this application, except for arguments specifically directed to the claim.

Claim Rejections - 35 USC § 102

The Examiner rejected claims 1-14 under 35 USC § 102(b) as anticipated by Sumino (JP 10-172147). This rejection is respectfully traversed.

The invention disclosed by Sumino relates to an optical disc play back apparatus configured to:

- compare a peak-to-peak difference of a signal with a reference value;
- turn off a tracking servo when the peak-to-peak difference is less than the reference;

- move the pickup sled by a predetermined distance towards the inner circumference side or outer circumference side of the optical disc;
- turn on the tracking servo; and
- repeat the above steps until the optical pickup has escaped from an information non-recorded area of the disc.

Thus the apparatus disclosed by Sumino allows an optical pickup to escape from an area of the disc where no information is recorded. However, the method of Sumino apparently relies upon a single peak value and a single bottom value, held in respective hold circuits, to determine the peak-to-peak difference of the signal (see Sumino [0022]). Thus the apparatus of Sumino may erroneously determine that the pickup is in an information recorded area when the pickup is in an unrecorded area where a scratch or a dust particle causes a high peak signal value.

MPEP §2131 provides:

“A claim is anticipated only if each and every element as set forth in the claim is founded, expressly or inherently described in a single prior art reference.” *Verdegaal Bros v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The rejection under 35 USC § 102(b) as anticipated by Sumino is traversed specifically because Sumino does not anticipate, expressly or inherently, the limitation “according to whether the level detected by the signal level detector continues to be above or below a predetermined reference value during a predetermined time period” as found in independent claims 1 and 14.

In the rationale for the rejection of claim 13, the Examiner stated “In Sumino, said determining circuit determines the position of said optical pickup based on the level of signal obtained from said reflected light during a predetermined time period (this is inherent: it samples and holds the signal, so the sample time must be predetermined)”. On the contrary, it is respectfully submitted that the presence of a peak hold circuit and a bottom hold circuit expressly

discloses that Sumino determines the pickup position from the signal values at two discrete instances in time. Thus the determining circuit of Sumino inherently does not determine the pickup position “according to whether the level detected by the signal level detector continues to be above or below a predetermined reference value during a predetermined time period”.

It is respectfully submitted that Sumino does not anticipate the limitation “according to whether the level detected by the signal level detector continues to be above or below a predetermined reference value during a predetermined time period”. Thus independent claims 1 and 14, and the claims depending therefrom, are allowable.

Conclusion

It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

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The Examiner is invited to call the undersigned registered practitioner to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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John E. Gunther, Reg. No. 43,649

SoCal IP Law Group LLP
310 N. Westlake Blvd., Suite 120
Westlake Village, CA 91362
Telephone: 805/230-1350
Facsimile: 805/230-1355
email: info@socalip.com